

REMARKS/ARGUMENTS

In this Amendment, claims 24-28 have been cancelled and claims 1, 13, 19, 21, and 23 have been amended. Claims 1, 13, 19, 21, and 23 were amended to include the subject matter of claims 24, 25, 26, 27, and 28, respectively. Claims 1-16 and 18-23 remain in this application.

Claim Rejections – 35 USC § 112, first paragraph. The Office Action rejected claims 1-16 and 18-28 under Section 112, first paragraph, as containing subject matter which was not adequately described in the specification. In particular, the Examiner believes the wording “automatically determining” in claims 1, 19, and 20 and the wording “substantially simultaneously” in cancelled claims 24-28, are not adequately described and enabled in the specification.

Regarding the “automatically determining” step, the specification at page 11, lines 11-15, discloses that in most cases a quotation for human translation is determined, but in some cases, a recipient may not require a quote for a human translation. “A filter 15 checks for situations in which a quote for human translation is not required. This may be according to standard instructions by some recipients.” Further at page 11, lines 22-24, “an expert system could be employed to ‘learn’ the situations in which a given recipient requires human translation.” Both of these methods are techniques for “automatically determining” if a quotation for a human translation is required, and the use of either method—standard instructions or an expert system—is within the knowledge of those skilled in the art.

In view of the foregoing, Applicant submits that specification discloses the “automatically determining” step in sufficient detail to establish that the inventor had possession of the claimed invention at the time the application was filed and that one skilled in the art could make and use the invention without undue experimentation in accordance with Section 112, first paragraph. Withdrawal of the rejection is respectfully requested.

The wording “substantially simultaneously” is supported in the specification at page 12, lines 14-18, and in Figure 2. Those lines of the specification and step 18 of Fig. 2 make it clear that the communication, translation, and quotation are forwarded in a single step (step 18) to a recipient. The single step 18 shown in Figure 2 makes clear to one skilled in the art that the communication, translation, and quotation may occur “substantially simultaneously.” Page 12,

lines 15-16 state "This may occur by email to the recipient..." Thus, in one embodiment of the invention, "substantially simultaneously" may mean that the communication, translation, and quotation are forwarded in a single email or in a series of consecutive emails issued one immediately after another, as part of a single step.

In view of the foregoing, Applicant submits that specification discloses the "substantially simultaneously" step in sufficient detail to establish that the inventor had possession of the claimed invention at the time the application was filed and that one skilled in the art could make and use the invention without undue experimentation in accordance with Section 112, first paragraph. Withdrawal of the rejection under Section 112, first paragraph, is respectfully requested.

Claim Rejections – 35 USC § 112, second paragraph. The Office Action rejected claims 24-28 under Section 112, second paragraph, as being indefinite. According to the Examiner, the wording "substantially simultaneously" is vague and indefinite. Applicant submits that the wording "substantially simultaneously" is wording that would be understood by persons skilled in the art such that the wording does not render the claim vague and indefinite. The Court of Appeals for the Federal Circuit recently commented on the use of the word "substantially" in patent claims in the case *Verve LLC v. Crane Cams Inc.*, 65 USPQ2d 1051, 1054 (Fed. Cir. 2002):

Expressions such as "substantially" are used in patent documents when warranted by the nature of the invention, in order to accommodate the minor variations that may be appropriate to secure the invention. Such usage may well satisfy the charge to "particularly point out and distinctly claim" the invention, 35 U.S.C. § 112, and indeed may be necessary in order to provide the inventor with the benefit of his invention. In *Andrew Corp. v. Gabriel Elecs. Inc.*, 847 F.2d 819, 821-22, 6 USPQ2d 2010, 2013 (Fed. Cir. 1988) the court explained that usages such as "substantially equal" and "closely approximate" may serve to describe the invention with precision appropriate to the technology and without intruding on the prior art. The court again explained in *Ecolab Inc. v. Envirochem, Inc.*, 264 F.3d 1358, 1367, 60 USPQ2d 1173, 1179 (Fed. Cir. 2001) that "like the term 'about,' the term 'substantially' is a descriptive term commonly used in patent claims to 'avoid a strict numerical boundary to the specified parameter,'" quoting *Pall Corp. v. Micron Separations, Inc.*, 66 F.3d 1211, 1217, 36 USPQ2d 1225, 1229 (Fed. Cir. 1995).

It is well established that when the term “substantially” serves reasonably to describe the subject matter so that its scope would be understood by persons in the field of the invention, and to distinguish the claimed subject matter from the prior art, it is not indefinite.

The use of the term “substantially” in the present invention describes the step that may appear simultaneous to a recipient of a communication, translation, and quotation, but that is not strictly simultaneous when measured, for example, against the clock speeds of a computer that sends the communication, translation, and quotation.

The Amendment dated February 7, 2003 at page 5 explains the rationale for adding the “substantially simultaneously” language:

During the telephonic interview, ... Applicant noted that the pending claims recite the single step of forwarding the communication, the machine translation, and quotation to the recipient. The Examiner stated his opinion that the claims do not expressly exclude the *separate steps* of forwarding the communication and machine translation to the recipient, the recipient requesting a quote for a human translation, and thereafter forwarding the quotation to the recipient.

Thus, the “substantially simultaneously” language was added to the claims to exclude the situation where the communication and machine translation are forwarded to the recipient, the recipient requests a quote for a human translation, and thereafter separately forwarding the quotation to the recipient.

In accordance with the Federal Circuit’s decision in *Verve LLC v. Crane Cams Inc.*, the wording “substantially simultaneously” is not indefinite because it “serves reasonably to describe the subject matter so that its scope would be understood by persons in the field of the invention, and to distinguish the claimed subject matter from the prior art.” In view of the foregoing, Applicant submits that the wording “substantially simultaneously” is clear and definite according Section 112, second paragraph. Withdrawal of the rejection is respectfully requested.

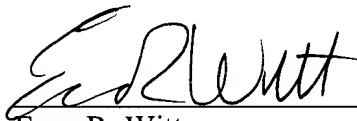
Claim Rejections – 35 USC § 103. The Office Action rejected claims 1-16 and 18-23 under Section 103(a) as being unpatentable over Japanese Patent Application No. 10124516 (hereinafter, “JP516”) in view of U.S. Patent No. 5,608,622 to Church (hereinafter, “Church”) and Globalink. Because claims 24-28 were not rejected under Section 103(a), the subject matter

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of these claims has been incorporated into their respective base claim. Therefore, Applicant submits that amended claims 1-16 and 18-23 are not properly rejected under Section 103(a). Applicant requests withdrawal of the rejection. In view of the following remarks, reconsideration and allowance of claims 1-16 and 18-23 are respectfully requested.

If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,



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